

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Zaihui Zhang et al.
 Application No. : 10/520,250
 Confirmation No. : 5096
 Filed : October 28, 2005
 For : COMPOUNDS AND METHODS FOR TREATING CANCER AND
 INFLAMMATION

Examiner : Timothy P. Thomas
 Art Unit : 1614
 Docket No. : 540057.414USPC
 Date : September 27, 2007

Mail Stop Amendment
 Commissioner for Patents
 P.O. Box 1450
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Commissioner for Patents:

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Restriction Requirement mailed August 28, 2007. Claims 1, 40, 42-43 and 45-77 are pending in this application.

Restriction requirement under 35 U.S.C. 121 and 372.

The Examiner contended that the following inventions or groups of inventions were not so linked as to form a single general inventive concept under PCT Rule 13.1. Accordingly, Applicants are required to elect a single invention to which the claims must be restricted.

- Group I Claim(s) 1, 54-77 (in part), drawn to a pharmaceutical composition.
- Group II Claim(s) 40, 42-43, 45-52, 54-77 (in part), drawn to a method of treating a mammal.

The Examiner contended that the inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups I-II is a compound of formula I. Kreighbaum et al. (US 4,015,006; IDS Reference AB) teach a group of compounds, such as formula I (column 1), which reads on the instant formula I of claim 1, administration to dogs are also taught (column 5, lines 10-22). It is noted that the purpose taught by Kreighbaum is not the same as that claimed for the pharmaceutical composition of claim 1, however, the composition taught by Kreighbaum would also be useful for the purpose of instant claim 1, since it contains the same active ingredient. Since the technical feature has previously been disclosed, the technical feature lacks novelty. Therefore the technical feature linking the inventions of groups I-II does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the prior art. Accordingly, Groups I-II are not so linked by the same or a corresponding special technical feature as to form a single inventive concept.

Accordingly, Applicants hereby elect Group II (Claims 40, 42-43, 45-52 and 54-77 (in part) for examination.

The Examiner also contended that the application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Accordingly, the following species election is required:

- (i) If either Group I or II is elected, Applicants are required to elect a single disclosed compound species of formula (I); and
- (ii) If Group II is elected, Applicants must elect the following (iia) or (iib) and also a species for (iic):
 - (iia) a method of treating a mammal (*in vivo*; claim 45); or
 - (iib) a method of treating a mammalian cell, *in vitro* (claim 48); and
 - (iic) a single disclosed disease or disorder.

Accordingly, in view of the election of Group II above, Applicants hereby elect the compound species of formula (I) set forth in the Specification on page 33, in Table 1, *i.e.*, 2-benzyl-1-ethyl-6,7-dimethoxy-2*H*-isoquinolin-3-one. Claims 1, 40, 42-43, 45-53, 54-55, 64-65, 71 and 77 read on this species.

In addition, Applicants elect the *in vivo* method of treating a mammal of Claim 45 and elect inflammation as the single disclosed disease or disorder.

Applicants reserve the right to file separate divisional applications on any non-elected subject matter under 35 U.S.C. 121.

Applicants note that the Examiner incorrectly listed U.S. 4,014,006 (Sorensen *et al.*) on Form PTO-892 accompanying the Restriction Requirement. The correct patent number is U.S. 4,015,006 (Kreighbaum), as referenced above by the Examiner. Issuance of a corrected Form PTO-892 is hereby requested.

Reconsideration of the claimed subject matter is hereby requested in view of the foregoing remarks.

Respectfully submitted,
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